



Paper No. 15

WORLDCOM, INC.
1133 19TH STREET NW
WASHINGTON, DC 20036

COPY MAILED**APR 16 2003**

In re Application of
Dugan et al.
Application No. 09/421,590
Filed: October 20, 1999
Attorney Docket No. COS-98-021

OFFICE OF PETITIONS
ON PETITION

This decision concerns the February 16, 2000 petition under 37 CFR 1.47(a).¹

The petition is **DISMISSED**.

Five inventors are named in this application. The petition, accompanied by a declaration signed by all of the inventors except Allen Holmes ("Holmes") ("2/16/00 Declaration"), asserts that Holmes refuses to sign the declaration and requests that the available inventors be allowed to file this application on behalf of themselves and Holmes.

Under 37 CFR 1.47(a), the available inventors may file this application on behalf of themselves as well as Holmes provided that a *bona fide* attempt has been made to present to Holmes, for review and signature, a copy of the **entire application (specification including claims; drawings)**; and that the latter refuses to join in this application.²

To show that Holmes has refused to join in this application despite such a *bona fide* attempt, the petition must include, *inter alia*, a statement of facts concerning the circumstances of the presentation of the application papers to Holmes at his last known address,³ and his subsequent refusal.⁴

¹ This petition was recently forwarded to the Office from the Examiner. The Office sincerely apologizes for any inconvenience caused by the delay.

² See *infra* note 4.

³ 37 CFR 1.47(a); MPEP section 409.03(e) (Aug. 2001).

⁴ MPEP section 409.03(d) (Aug. 2001) (Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted . . . When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.).

The petition encloses an affidavit by Albert M. Crowder, Jr. ("Crowder") ("Crowder Affidavit"), counsel for Assignee, setting forth that:

- (1) Holmes, "when contacted regarding execution of the declaration and assignment relating to the . . . application, . . . refused to join in . . .";⁵
- (2) In September of 1999, a copy of the application "was delivered to [Holmes at] his last known address";⁶
- (3) Holmes "informed MCI WorldCom that he refused to join in this application" but Crowder went ahead and sent Holmes a reminder letter in February of 2000;⁷ and
- (4) Holmes has declined to reply.⁸

However:

- The petition does not specify who made the contact with Holmes, and in what manner [(1) above]; or to whom in MCI did Holmes indicate his refusal to join in this application [(3) above];
- It is unclear who delivered, or had delivered, to Holmes, a copy of the application in September of 1999; or whether that copy of application was complete with the specification including claims, as well as drawings [(2) above];
- The petition provides no explanation how Crowder reached his conclusion in (4), that Holmes declined to reply [to Crowder's requests]; or that Holmes' lack of response represents his refusal to join in this application.⁹

Consequently, the Office is unable to conclude that the Crowder Affidavit constitutes the "statement of facts" required for granting a petition under 37 CFR 1.47(a). The instant petition is thus dismissed, and the 2/16/00 Declaration is not accepted.

⁵ Crowder Affidavit, page 1, paragraph 3.

⁶ Crowder Affidavit, page 1, paragraph 4, 2nd sentence.

⁷ Petition, page 1, paragraph (II)(2), 2nd to the last sentence.

⁸ Petition, page 1, paragraph (II)(2), last sentence; Crowder Affidavit, page 1, paragraph 4, last sentence: "Holmes has steadfastly refused to reply to our requests."

⁹ There is no evidence that counsel has confirmed with Holmes regarding his receipt of the application papers delivered in September of 1999.

Options

To prevent abandonment of this application, **either** of the following must be filed within **TWO MONTHS** from the mailing date of this decision:¹⁰

OR, (1) An oath/declaration properly executed by **all** of the inventors, including Holmes;¹¹

(2) A renewed petition under 37 CFR 1.47(a) (no fee) that:

-includes appropriate statement(s) regarding: the fact that a copy of the entire application (specification including claims; drawings) was provided to Holmes at his last known address; and, those facts relied upon to conclude that Holmes refuses to join in this application; and

-is addressed as follows:

by mail/by hand: Commissioner for Patents, USPTO
Attn: Office of Petitions
Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

by fax: (703) 308-6916
Attn: Office of Petitions

As authorized in the instant petition, the \$130 petition fee has been charged to Deposit Account No. 13-2491.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.



RC Tang
Petitions Attorney
Office of Petitions

¹⁰ Unless proper extension(s) of time under 37 CFR 1.136(a) is (are) obtained. See 37 CFR 1.53(f) (If an application which has been accorded a filing date . . . does not include an oath or declaration by the applicant pursuant to §1.63 . . . , applicant will be notified and given a period of time within which to . . . file an oath or declaration . . . and pay the surcharge required by §1.16(e) to avoid abandonment.).

¹¹ Submit directly to the Office of Initial Patent Examination, along with a copy of this decision.